

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	MONK et al.	:	Group Art Unit:	3746
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Application No.:	10/617,329	:	Examiner:	S. Belt
		:		
Filed:	July 10, 2003	:	Confirmation No.:	2818
		:		
For:	RECIPROCATING COMPRESSOR WITH LINEAR MOTOR			

RESPONSE UNDER 37 C.F.R. 1.111

Mail Stop AMENDMENT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Please consider the following Response for the above-referenced Application.

REMARKS

The Office Action of May 2, 2006 subjects Figures 1-3 in the present Application to a restriction requirement. The Examiner has required restriction to one of the following figures purportedly under 35 U.S.C. § 121:

Figure 1 illustrates a 1st embodiment of a mechanical linkage being a connecting rod type mechanism.

Figure 2 illustrates a 2nd embodiment of a mechanical linkage being a gear type mechanism.

Figure 3 illustrates a 3rd embodiment of a mechanical linkage being a track type mechanism.

To begin, Applicant submits that the attempted restriction requirement of the Examiner is improper and should be withdrawn. 35 U.S.C. § 121 states "[i]f two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions." Thus, a restriction can only be given when there are two or more independent and distinct inventions **in the claims**. This requirement for two or more inventions to be recited in the claims is repeated in 37 CFR §§ 1.141 and 1.142 and in Chapter

800 of the MPEP. Furthermore, Applicant cannot identify any authority that permits an Examiner to restrict an application based on what is illustrated in the drawings of the application. The Examiner is requested to cite the appropriate authority providing for a restriction requirement based on the drawings of the application. Therefore, since the Examiner has failed to identify the presence of two or more inventions in the claims and has no authority to base a restriction requirement on the drawings, Applicant submits that the Examiner's restriction requirement is improper and should be withdrawn.

However, in the interest in expediting prosecution of the Application and in accordance with the requirements of 37 CFR § 1.143 Applicant elects, with traverse and without prejudice, Figure 1 illustrating a mechanical linkage as a connecting rod mechanism, corresponding to claims 1-4 and 15-18. Claims 1 and 15 are currently generic to all Figures.

Assuming for argument purposes only that the restriction requirement is proper, Applicant traverses the restriction requirement for the following reasons.

First, there is no undue burden placed on the Examiner by examining all of the claims corresponding to Figures 1-3.

To begin and in further support of Applicant's assertion that the restriction requirement is improper, the Examiner has failed to identify any reasons as to why examination of all of the claims would place an undue burden on the Examiner as required in MPEP 803. In the Office Action, the Examiner has not even stated that examination of all of the claims would place a serious burden on the Examiner, let alone provide any support for such a position. Thus, Applicant asserts that the Examiner's restriction requirement is improper and should be withdrawn.

Furthermore, Applicant asserts that to conduct a proper examination of the claims, all of the Figures must be searched to meet the thoroughness requirement of the rules. The Figures dealing with one type of linkage may contain a reference that incidentally discusses another linkage that is pertinent to the present invention. The rules provide:

On taking up an application for examination or a patent in a reexamination proceeding, the Examiner shall make a thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention. The examination shall be complete with respect both to compliance of the application or patent under reexamination with the applicable

statutes and rules and to the patentability of the invention as claimed, as well as with respect to matters of form, unless otherwise indicated. [37 CFR 1.104(a)].

There has been no showing that a search of all of the Figures would pose a serious burden on the Examiner, and all of the Figures should be searched. Multiple figures are routinely searched when applications are examined, and there is no reason that all of the Figures cannot be searched in this case. MPEP 803 states:

"If the search and examination of all of the claims in an application can be made without serious burden, the Examiner must examine them on the merits, even though they include claims to independent or distinct inventions."
[Emphasis added]

Given that 37 CFR § 1.104(a) mandates a thorough examination, which would presumably include searching all Figures, the mandate of MPEP 803 requires that all inventions be examined. If the restriction is maintained, Applicant asks that the Examiner demonstrate why a search of all Figures would pose a serious burden, and in fact why all Figures should not be searched to meet the thoroughness requirement. Applicant wants a thorough search of its invention, and is concerned that the search may be less than thorough if certain embodiments are arbitrarily excluded for restriction reasons.

Next, the restriction is made pursuant to 35 USC § 121. The claims must be shown to be "independent and distinct" to maintain the restriction, 35 USC § 121, 37 CFR § 1.141, MPEP 802. Since this requirement is statutory, it is not proper to interpret the statute in any other fashion. 35 USC § 121 provides no basis for restriction on the ground that the Figures contain different embodiments.

The Examiner asserts that the inventions are "independent" or "distinct", which is not the requirement set forth in 35 USC § 121. Furthermore, the Examiner has provided no reasons as to how or why the Figures show independent and distinct inventions other than a conclusory statement that they are drawn to a "different inventive concept". If the Examiner maintains the restriction requirement, the Examiner is requested to explain how the Figures illustrate independent and distinct inventions.

Applicant requests a prompt and favorable action by the Examiner. If the Examiner believes that prosecution of this Application could be expedited by a telephone conference, the Examiner is encouraged to contact the Applicant.

The Commissioner is hereby authorized to charge any additional fees and credit any overpayments to Deposit Account No. 50-1059.

Respectfully submitted,
McNEES, WALLACE & NURICK LLC

/Brian T. Sattizahn/

By

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Dated: June 29, 2006